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DEC 15 2006

Application No. 10/678,408

REMARKS

The Office Action of June 15, 2006 has been received and reviewed. This response, submitted along with a Petition for a Three-Month Extension of Time, is directed to that Action.

Claims 1, 17 and 18 have been amended. Claim 16 has been cancelled. Support for the amendments to claim 1 and 18 can be found on page 6, lines 7-14, Table 1 and claim 16 of the originally filed specification. No new matter is believed to have been added.

The applicants additionally include a signed declaration from Steven Donnelly, a co-inventor of the present invention.

The applicants respectfully request reconsideration based on the foregoing amendments and the following remarks.

Claim Rejections- 35 U.S.C. §103

The Examiner rejected claims 1-3, 10 and 14 under 35 U.S.C. §103(a) as obvious over the "Horodysky references" (US 4,389,322; 4,478,732; or 4,594,171) or Doner et al. (US 5,068,045) in view of Karol (US 5,055,584) or Karol (4,761,482). Furthermore, the Examiner made the following additional rejections: claims 1-3, 6-9 and 16-18 under 35 U.S.C. §103(a) as obvious over the Horodysky references or Doner in view of Nakazato et al. (5,629,272), claims 1-3, 11, 16-18 under 35 U.S.C. §103(a) as obvious over the Horodysky references or Doner in view of either Holt et al (US 6,187,723) or Atherton (US 5,925,600), and claims 1-3, 12-13, 16

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and 18 are rejected under 35 U.S.C. §103(a) as obvious over the Horodysky references or Doner in view of Rowan (US 4,889,647).

The Examiner stated that the Horodysky references and Doner disclose an organo borate ester composition in the form of borated derivatives of ethoxylated amides which are effective friction reducing additives for lubricating oils. The Examiner further stated that the component (2) additives of the present claims are known as conventional additives in the lubricating oil art, and additionally that the secondary references teach the additives of component (2).

Accordingly, the Examiner concluded that it would have been obvious to a person of ordinary skill in the art to combine the references to arrive at the presently claimed invention. The applicants respectfully traverse this rejection.

A *prima facie* case of obviousness can be rebutted with a showing of new and unexpected results. The applicants submit that the present invention exhibits unexpected results when an organo borate ester additive is combined with any of the additives of component (2) in an amount according to the claimed ratio. This is clearly set forth in data in the specification and in the enclosed declaration. The first paragraph on page 27 of the originally filed specification clearly explains that while high concentrations of borate ester alone (1% by mass or greater in relation to the lubricating composition as a whole) provide adequate antiwear protection, lower amounts of the same borate ester used alone lead to significantly inferior antiwear performance (Table A; Table 1, compare tests 1 and 10).

However, the present invention surprisingly discovered that acceptable antiwear results can be achieved even when using low amounts (<1% by mass) of borate ester if combined,

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according to the claimed ratio, with the additive of component (2). This synergy can be clearly seen in the data presented in the specification. There is nothing in the prior art references cited in the present Office Action that suggests that such a synergy is possible.

The Examiner stated in the recent Office Action that the test results set forth in the specification are not commensurate in scope with the claimed ratios. Accordingly, the declaration enclosed herewith presents additional data showing that the claimed synergy between the components exists over the entire claimed ratio. In this regard, please see examples A, B, C, F, G, H, I, L, M, N, Q and R.

Accordingly, the applicants submit that the data in the present application supports the fact that the present invention shows unexpected and surprising results with respect to antiwear performance, which can be attributed to the synergy of the components when used according to the ratios of the present invention. For these reasons, the applicants respectfully request that the Examiner withdraw the present rejections.

The applicants also believe that this application is in condition for immediate allowance. However, should any issue(s) of a minor nature remain, the Examiner is respectfully requested to telephone the undersigned at telephone number (212) 808-0700 so that the issue(s) might be promptly resolved.

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**CONDITIONAL PETITION FOR EXTENSION OF TIME**

If entry and consideration of the amendments above requires an extension of time, Applicant respectfully requests that this be considered a petition therefor. The Commissioner is authorized to charge any fee(s) due in this connection to Deposit Account No. 14-1263.

**ADDITIONAL FEE**

Please charge any insufficiency of fees, or credit any excess, to Deposit Account No. 14-1263.

Respectfully submitted,  
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